

## **REMARKS**

In response to the above-identified Final Office Action (“Action”), Applicants traverse the Examiner’s rejection to the claims and seek reconsideration thereof. Claims 1 and 3-6 are pending in the present application. Claims 1 and 3-6 are rejected. In this response, claim 1 is amended, no claims are cancelled and no claims are added.

### **I. Claim Amendments**

Applicants respectfully submit herewith amendments to claim 1. Claim 1 is amended to recite “wherein the polymerization is carried out in the presence of a catalyst selected from the group consisting of antimony-based catalyst, germanium-based catalyst and titanium-based catalyst.” Support for the amendments to claim 1 may be found, for example, on page 6, lines 16-18 and Examples 2 and 3 of the Application.

Applicants respectfully submit the amendments do not add new matter and are supported by the specification. Accordingly, Applicants respectfully request consideration and entry of the amendments to claim 1.

### **II. Claim Rejections – 35 U.S.C. §103**

In the outstanding Action, claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0049285 issued to Abe (“Abe”) in combination with U.S. Patent No. 6,436,548 issued to Phelps (“Phelps”). Applicants respectfully traverse the rejections.

To establish a *prima facie* case of obviousness, the Examiner must set forth “some articulated reasoning with some rational underpinning to support the conclusion of obviousness.” See KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007). In combining prior art elements to render the claimed combination of elements obvious, the Examiner must show that the results would have been predictable to one of ordinary skill in the art. See Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103, Section III(D), issued by the U.S. Patent and Trademark Office on October 10, 2007.

In regard to claim 1, Applicants respectfully submit that Abe and Phelps fail to disclose or render predictable at least the element of “wherein the polymerization is carried out in the presence of a catalyst selected from the group consisting of antimony-based catalyst, germanium-based catalyst, and titanium-based catalyst.” Applicants submit that the combination of (i) a cyclic amide monomer, (ii) macrocyclic polyester oligomer and (iii) the antimony, germanium or titanium-based catalyst as claimed improves the compatibility of a polyester component and an amide component, which results in, for example, reduced phase separation and improved transparency.

In the Action, the Examiner alleges that Abe discloses each of the elements of previously presented claim 1 except for the element of a cyclic ester being an oligoester. The Examiner instead alleges that Phelps discloses this element. The Examiner has not identified a portion of Abe or Phelps disclosing the claimed catalysts.

Rather Abe uses a catalyst such as an alkali metal, an alkali earth metal, and so on for copolymerizing a cyclic amide and an ester. See Abe, paragraph [0084]. Phelps uses an organotin or organotitanate catalyst for the polymerization of macrocyclic polyester oligomers (MPOs). See Phelps, col. 8.

Applicants further submit that it would not have been obvious to a person of ordinary skill in the art to select (i) a cyclic amide monomer and (ii) macrocyclic polyester oligomer from various amides and various polyesters to achieve the reduced phase separation and improved transparency achieved by the method of claim 1. Neither Abe nor Phelps disclose or contemplate such results. Rather, Abe is directed to an antistatic molded article having a desired surface resistivity. See Abe, paragraph [0008]. Phelps is directed to a method for modifying physical properties (e.g., melting temperature) of macrocyclic polyester by adjusting the mixing ratio of macrocyclic polyesters.

Thus, for at least the foregoing reasons, the combination of Abe and Phelps may not be relied upon to disclose each of the elements of claim 1. Since each of the elements of claim 1 are not disclosed by the prior art, a *prima facie* case of obviousness may not be established with respect to claim 1 and its dependent claims. Accordingly, Applicants respectfully request

reconsideration and withdrawal of the rejection of claims 1 and 3-6 under 35 U.S.C. §103 over Abe and Phelps.

### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1 and 3-6, are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

Respectfully submitted,

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#### **CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on August 21, 2008.

Suzanne Johnston